

REMARKS/ARGUMENTS

Claims 1, 2 and 4 are pending in this application. Claim 2 has been amended and claim 4 has been added. The amendment is fully supported by the original disclosure. No new matter has been introduced. Reconsideration and allowance of claims 1, 2 and 4 in view of the following remarks is respectfully requested.

The objection to the drawings under 37 C.F.R. 1.83(a) and the objection to the specification under 37 C.F.R. 1.75(d)(1):

The Examiner has objected to the drawings and the specification for not showing and describing each and every feature of the invention specified in the claims.

In response, Applicant has provided two new paragraphs following page 4, line 27, of the specification as well as amended Figs. 2 and 3. The two new paragraphs mirror the language of original claims 1 and 2, and therefore do not constitute new subject matter. Proper antecedent basis for all the terms in pending claims 1 and 2 can accordingly be found in this new portion of the specification. Additionally, numerals 37A and 37B have been added to Figs. 2 and 3 to reenumerate horizontal leg 37A and vertical leg 37B of drain pipe 34. Applicant believes all of the Examiner's concerns regarding proper antecedent basis for the claim terminology in the specification and figures is addressed by this amendment.

The rejection of claim 2 under 35 U.S.C. § 112:

The Examiner has rejected claim 2 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner objects to the recitation of "the cap" in line 7.

In response, Applicant has moved this portion of the claim to the end of the claim so that "the cap" has proper antecedent basis.

The rejection of claim 2 under 35 U.S.C. 102:

The Examiner has rejected claim 2 under 35 U.S.C. 102 as being anticipated by Delanoy.

Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharm., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Claim 2, as amended, requires in part "an overflow pipe having a first exposed end....[having] an externally threaded portion," and a "cap threadably mounted on the externally

threaded portion of the first end." In contrast, Delanoy teaches a cap 6 having an annular ring 7 that is externally threaded 8 to correspond with the internal threads 3 of the trap 2 of a drainage pipe. (Lines 43-53). The cap 6, or bushing is screwed into the upper end of the trap and remains in place until after the pressure test is applied to the rough plumbing and prior to connecting waste pipe 5. (Lines 70-84). Delanoy does not teach a cap that is threadably mounted to the first end of an overflow pipe, nor does Delanoy teach a cap that is threadably mounted on the externally threaded portion of any pipe. Therefore, because Delanoy does not teach each and every limitation set forth in claim 2 it does not anticipate and the Examiner's rejection should be withdrawn.

The rejection of claim 2 under 35 U.S.C. 103:

The Examiner has also rejected claim 2 under 35 U.S.C. 103(a) as being unpatentable over Delanoy in view of Lewis.

The Applicant respectfully disagrees. An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ

303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of

multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

This obvious rejection asserted by the Examiner is based on a combination of prior art references, e.g. the the cap assembly of Delanoy, combined with the external overflow drain of Lewis. To justify this combination the Examiner simply stated "[i]t would have been obvious to one of ordinary skill in the bathtub cap or test plug system art, at the time the invention was made, to substitute for the inner screw mounting of the cap assembly into the pipe of Delanoy, the outer screw mounting of the cap assembly onto the pipe as, for example, taught by Lewis wherein so doing would amount to mere substitution of one screw attachment mechanism for another that would work equally as well in the Delanoy device."

The Examiner further justifies the combination by directing the Applicant's attention to Lewis which "discusses another plumbing bathtub test system (note ¶ 0008) having a cap assembly (constituted by test plug 8) which can be threadably mounted to pipe elbow 20 either via outer screw threads or inner screw threads (note ¶ 0020). Applicant respectfully disagrees. The test plug 8 of Lewis is inserted within elbow 20 such that threaded screw 5 is caused to mate with threaded opening 51 (Fig. 6) and tightened by the application of wing nut 7. (Note ¶ 0027). The interchangeability of threads relates to the capture nut 21 which compressively draws elbow 20 to tub 10 and not to the test plug 8. Thus, Lewis does not suggest the combination as proposed, and rather teaches away from the claimed invention.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the Applicant took. In re Gurley, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).

Lewis teaches the use of a test plug 8 for water testing. To create a water-tight seal, as previously discussed, the test plug is screwed down within elbow 40 by mating screw 5 within threaded opening 51 supported within elbow 40 by extruded protrusion 50. Thus, upon reviewing Lewis, one skilled in the art would have been led in a direction where a plug with a centrally located screw is used to secure the plug to the pipe rather than the path the Applicant took.

Accordingly, because the Examiner has not particularly identified any suggestion, teaching, or motivation to combine the prior art references, in addition to the disclosure of Lewis which teaches away from the proposed combination, the Examiner's conclusion of obviousness, as a matter of law, cannot stand.

In addition, even if there was a suggestion or motivation to combine the references, the combination would not result in the invention as claimed. More specifically, the combination would possibly result in the cap assembly of Delanoy, mounted to external threads of the trap of a drain pipe and not the external threaded portion of an overflow pipe as is required by claim 2. The only way to arrive at the claimed invention is to use Applicant's disclosure as a blue print which constitutes impermissible hindsight analysis. Therefore, Applicant respectfully requests that the Examiner's obviousness rejection be withdrawn.

The rejection of claim 1 under 35 U.S.C. 102 or 103:

The Examiner has rejected claim 1 under 35 U.S.C. 102 or 103(a) as being unpatentable over Ball.

Applicant respectfully traverses, as Ball does not teach or suggest all the claim limitations. Specifically, Ball does not have either a "horizontal leg extending into and through the overflow port of the bathtub" or "a cap threadably mounted on an end of the horizontal leg extending through the overflow port" as recited in claim 1. Additionally, claim 1 was earlier rejected in the July 7, 2004 office action in view of Ball and Lewis. In this office action, the examiner acknowledged the failures of Ball noting that "Ball fails to disclose that the horizontal leg of the drain pipe 34 extending through the overflow port 30 and the cap 70 have cooperating threads". Applicant believes the Examiner's July 7, 2004 interpretation of the failures of Ball to be correct, and Ball fails to meet at least these two limitations of claim 1.

Additionally, Ball does not disclose "threads on the horizontal leg extending through the overflow port" as recited in claim 1. In the recent office action the examiner has failed to even address the limitation. However, the Examiner did note that the screws 78 "connect to the tabs 56 and 58". Reference to Fig. 2 of Ball shows that these tabs 56 and 58 are not located on a "horizontal leg extending through the overflow port" as required by claim 1, and are instead located exterior to the overflow port. Accordingly, Applicant submits claim 1 is novel and not obvious in view of Ball.

New Claim 4

Applicant has submitted new claim 4 which it believes to be in the form of allowance. The claim requires, in part, a cap

threadably mounted to external threads on an overflow pipe. The cap has an outer face, an aperture at an open end, a body with interior threads that mate with the external threads of the overflow pipe. Affixed to the outer face of the cap is a thin sealing membrane. For at least the reasons previously discussed, Applicant submits that new claim 4 is novel, non-obvious, and should be allowed.

Conclusion:

In view of the above amendment and remarks, Applicant believes that claims 1, 2 and 4 are in condition for allowance and respectfully requests allowance of such claims.

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



Timothy J. Zarley  
Reg. No. 45,253  
ZARLEY LAW FIRM, P.L.C  
Capital Square  
400 Locust Street, Suite 200  
Des Moines, IA 50309-2350  
Phone No. (515) 558-0200  
Fax No. (515) 558-7790  
Customer No. 34082  
Attorneys of Record

TJZ/JJL/kc

Attachments

**Amendment to the Drawings:**

The attached sheet of drawings includes changes to Figs. 2 and 3. This sheet, which includes Figs. 2 and 3, replaces the original sheet including Figs. 2 and 3. In Fig. 2, previously omitted element 37A has been added. In Fig. 3, previously omitted elements 37A and 37B have been added.

Attachment: Replacement Sheet

Annotated Sheet Showing Changes



Re]

~37B

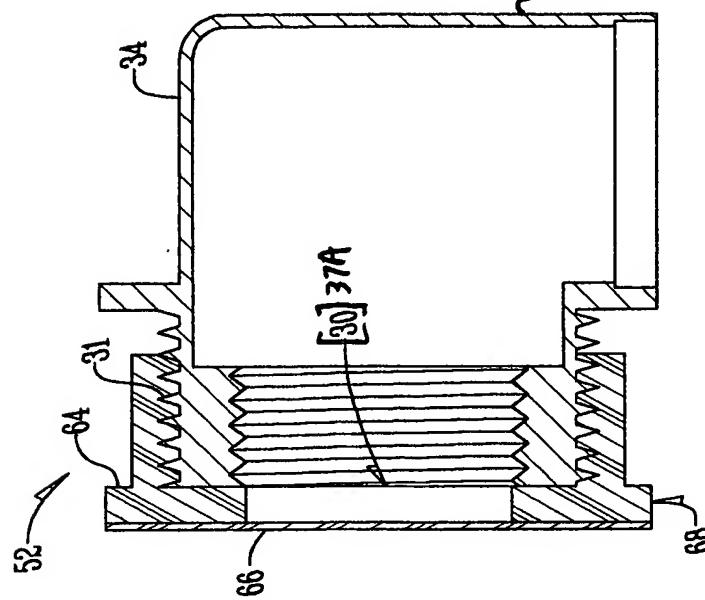


Fig 3

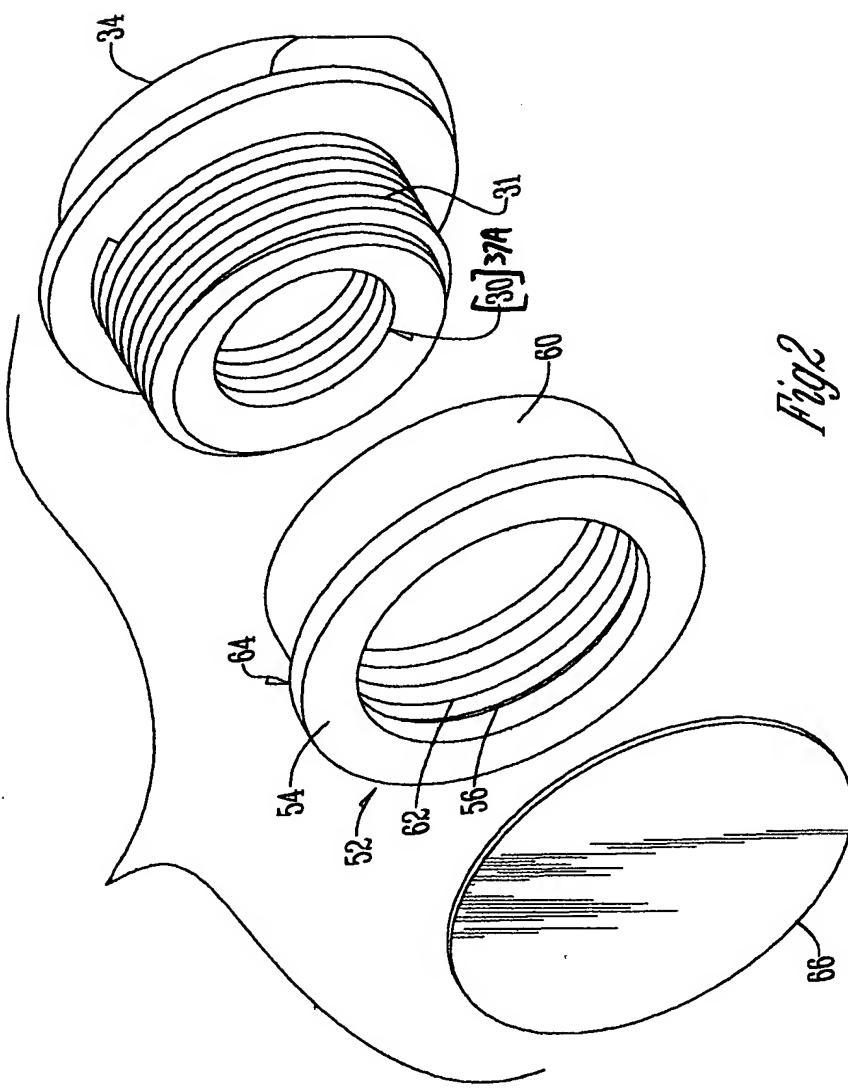


Fig 2